

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GREGOR J. SUTCLIFFE

Appeal No. 2001-2170
Application No. 08/116,873¹

ON BRIEF

MAILED

MAR 27 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before, WILLIAM F. SMITH, ADAMS, and GREEN, Administrative Patent
Judges.

ADAMS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not
in condition for a decision on appeal. Accordingly, we remand the application to
the examiner to consider the following issues and to take appropriate action.

Claims 26-33 are pending. The examiner indicated (Final Office Action,
page 1) that claim 31 is allowed. Claims 26-30, 32 and 33 are on appeal. Claim

¹ We note that this application claims priority through a number of applications to parent
Application No. 06/516,136. The File Wrapper of the instant application, however, incorrectly
refers to this parent application as 07/516,136. Upon return of this application to the examiner,
the examiner should insure that the File Wrapper references the correct parent application.

26 is illustrative of the subject matter on appeal and is reproduced below:

26. Isolated and purified DNA having about 500 to about 1800 nucleotide bases that is complementary to cytoplasmic messenger RNA of a mammal that is present in brain cells but not in the cells of the liver, kidney, gut, lung, heart or skeletal muscle of the same species, said messenger RNA encoding a neuroactive proteinoid.

The examiner does not rely on prior art.

GROUND OF REJECTION

Claims 26-30, 32 and 33 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

DISCUSSION

According to the examiner (Answer, page 4) "the claims read on so many DNAs (or mRNAs) that one cannot determine that which is intended." The examiner further finds (id.) "one cannot determine what is intended by 'having about 500 to about 1800 nucleotide bases that is complementary to cytoplasmic messenger RNA of a mammal that is present in brain cells....'" In addition, the examiner finds (id.) "... the intended functions of the claimed compositions are unclear."

Appellant takes each of the examiner's issues in order. First, with reference to In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) appellant argues (Brief, page 3) that while "[i]t can be agreed that the claims read on a large number of DNAs" breadth is not indefiniteness. The examiner does not address this argument. With regard to the examiner's second argument, appellant explains (Brief, pages 4-5) that the meaning of each claim

limitation is clear to a worker of ordinary skill to whom these claims are directed.

Appellant then explains (id.) how a person of ordinary skill in the art would interpret the length limitation, and the terms “complementary” and “cytoplasmic messenger RNA” as used in the claimed invention. While the examiner recognizes (Answer, page 5) appellant’s argument, she offers no response.

Finally, appellant argues (Brief, page 5) “[a]s to function of the DNAs, it is clear to a skilled worker that they are complementary to an mRNA that encodes a brain-specific proteinoid. The proteinoid is neuroactive. The function requested is thus asserted in the claims.” Once again the examiner fails to respond to this argument.

To the extent that the examiner is concerned about the structure of the claimed DNAs, appellant finds (Brief, page 5) that “[t]he structure of the DNAs need not be recited.” While appellant recognizes the examiner’s reliance on Ex parte Tanksley, 26 USPQ2d 1384 (Bd.Pat.App.&Int. 1991), appellant explains (Brief, pages 5-6) that on reconsideration, the Board in Ex parte Tanksley, 37 USPQ2d 1382 (Bd.Pat.App.&Int. 1994) noted “that one could claim the DNAs ... in question by ‘base sequence ... and/or function.’ Such a function has been asserted along with several base sequences. No more is needed under Tanksley [1994].” In response (Answer, page 6), “[t]he examiner contends that definite claim language is important for at least two reasons.” While the examiner then goes on to explain why definite claim language is important per se, she fails to address appellant’s arguments with regard to Tanksley. Instead,

the examiner simply restates her original conclusion and finds (*id.*) that *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) supports her position.

Merely relying on a different piece of case law, however, does not address the underlying factual basis of the rejection as argued by appellant.

As discussed above, the examiner either fails to address appellant's arguments, or cites new legal precedent to support her original conclusions. On this record, the examiner failed to provide a fact-based, reasoned explanation of her position, in response to appellant's arguments. In this regard, we remind the examiner that compliance with the second paragraph of section 112 is generally a question of law. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). Underlying this conclusion of law are findings of fact concerning the prior art, the particular invention, and how the claims would be read by those of ordinary skill in the art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). The amount of detail required to be included in the claims depends on these findings. *Shatterproof Glass*, 758 F.2d at 624, 225 USPQ at 641. "If the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." *Id.*

In addition, we note appellant's emphasis on a "proteiniod" that is "neuroactive." See Brief, page 5, Reply Brief, page 2. While, appellant's specification (page 14) defines the term "proteiniod" "to mean the direct

polypeptide [sic] translation product of a messenger RNA," the specification does not appear to provide a clear definition of the term "neuroactive." In this regard, we note that the specification describes (pages 28-48) the characterization of four exemplary brain-specific clones, designated p1A75, p1B236, p1B208 and p0-40.

In discussing the p1A75 clone, the specification discloses (page 36) that "[t]he organelle-like location of the proteinoid within cells suggests an involvement in secretory, transport or mitochondrial functions, and gives important clues as to how the determination of the function of this proteinoid may be approached." With regard to clone p1B236 the specification discloses (page 44) that:

Together with the structure of the p1B236 proteinoid, the morphological data strongly suggest that this proteinoid is a precursor for a new neuropeptide. The requirements that a polypeptide must meet to be considered a bona-fide neurotransmitter are rather strict, and the evidence that segments of the p1B236 proteinoid have a neurotransmitter function is circumstantial and preliminary from the above data. Nevertheless, it is believed that the p1B236 proteinoid or one or more of its cellularly processed derivatives are neurotransmitters.

According to the specification (page 47):

It is believed, from the probable abundance and the hydrophobicity of the putative amino acid residue sequence that the proteinoid encoded from p1B208 found in brain cell tissues is glial fibrillary acidic protein (GAFP), a known, prevalent very insoluble 55K dalton glial structural protein about which little is known at the molecular level.

At page 48, the specification discloses that clone p0-40 is believed to have "missed the proteinoid coding region of the corresponding mRNA.

This clone was consequently an unlikely choice for further investigation of hypothetical proteinoid products."

As demonstrated from the above review of the specification, the activity of the exemplary proteinoids appears to be, at best, based on circumstantial evidence. What is missing from the specification is a clear definition of the term "neuroactive." While the examiner concludes (Answer, page 7), "the functions of the DNAs (or mRNAs) as claimed have not been set forth as asserted by appellant," the examiner failed to explain the basis for, and to provide factual evidence to support this conclusion. We note that the Final Office Action included a rejection of claims 26-30, 32 and 33 under 35 U.S.C. § 112, first paragraph. This rejection, however, was subsequently withdrawn (Answer, page 5) without comment. Upon return of this application, the examiner should review the prosecution history and clarify why the rejection under 35 U.S.C. § 112, first paragraph was withdrawn.

OTHER MATTERS

We note that the October 27, 1994 Information Disclosure Statement includes a number of Scientific Reports (see e.g., Exhibits 1-9) that reference, inter alia, awards, honors and invited lectures of the instant inventor. However, no further information was provided, for example a description of the subject matter disclosed in the lectures. We assume that appellant intended to provide some information relevant to the claimed invention. Therefore, appellant should take this opportunity to clarify on this record whether appellant's Information

Disclosure Statement is incomplete, and if not to explain the relevance of Exhibits 1-9.

CONCLUSION

For the reasons set forth above the record before us is improperly briefed and not in condition for a decision on appeal. Accordingly, we remand this application to the examiner to consider these issues and to take appropriate action. On return of this application, the examiner should take a step back and review the administrative file, including the prosecution history, the specification and relevant prior art. If after this review the examiner believes that a rejection is necessary, the examiner should clearly articulate any such rejection in an appropriate Office Action.

We are not authorizing a Supplemental Examiner's Answer under the provisions of 37 CFR § 1.193(b)(1). Any further communication from the examiner that contains a rejection of the claims should provide appellant with a full and fair opportunity to respond.

REMANDED


William F. Smith

Administrative Patent Judge



Donald E. Adams

Administrative Patent Judge



Lora M. Green

Administrative Patent Judge

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